

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Burns)	Art Unit: 2434
)	
Serial No.: 10/789,556)	Examiner: Bayou, Yonas A
)	
Filing Date: 27 Feb 2004)	Docket No.: 0108-0245

For: "Methods And Apparatus For Automatically Grouping
User-Specific Information In A Mobile Station"

MAIL STOP AF
Commissioner for Patents, P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicant respectfully submits this *Pre-Appeal Brief Request For Review* in response to the Final Office Action mailed on 29 April 2010 for the above-identified patent application.

I. Summary of The Disclosure. First and second files for first and second applications, respectively, of a mobile station are maintained in storage. The first file includes a first user-specific information item which is utilized for identifying or contacting a user in the first application, and the second file includes a second user-specific information item which is utilized for identifying or contacting the user in the second application. In the technique, the mobile station detects a trigger signal. In response to detecting the trigger signal, the mobile station "automatically" groups the user-specific information items in the user information file. It does this by performing the following acts. The mobile station reads, from the first file stored in the mobile station, the first user-specific information item which is utilized for identifying or contacting the user in the first application. Then, the mobile station stores in the user information file the first user-specific information item read from the first file. The mobile station then repeats the acts of reading from the second file stored in the mobile station the second user-specific information item which is utilized for identifying

or contacting the user in the second application, and storing in the user information file the second user-specific information item read from the second file, so that the first and the second user-specific information items are automatically grouped together by the mobile station as user information in the user information file in response to detecting the trigger signal. After the first and the second user-specific information items have been automatically grouped by the mobile station in the user information file, the mobile station causes the user information file to be inserted in a message for transmission.

II. Claim Rejections. In the Office Action of 29 April 2010, the Examiner rejects claims 1-7, 9-22 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable based on Jin (U.S. Patent Application Publication No. US 2002/0084888 A1) in view of Minborg (U.S. Patent No. US 6,997,909 B2).

In the same Office Action, the Examiner rejects claims 1-7, 9-22 and 32-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

III. Clear Errors In The Examiner's Rejections. To properly establish claim rejections under 35 U.S.C. § 103(a), the prior art must teach or suggest each and every limitation of the claims.

1. The Examiner Commits Clear Error In Relying On The Jin Reference Which Clearly Fails To Teach Or Suggest The Claimed "Automatic" Grouping Of User-Specific Information Items In A User Information File But Rather Describes A "Manual" Process For The User/Manual Entry Of Data.

All pending claims 1-7, 9-22, and 32-34 are directed to techniques involving the "automatic" grouping of user-specific information items into a user information file "in response to detecting a trigger signal." The specific "automatic" grouping actions include "reading" a first user-specific information item from a first file for a first application and "storing" it in the user information file, and repeating these acts for a second user-specific information item from a second file (i.e. "reading" the second user-specific information item from the

second file for a second application and "storing" it in the user information file as well). As claimed, all of these grouping actions are performed "automatically" in response to the detection of the single trigger signal. See e.g. pending claim 1 of the application.

Words of a claim must be given their "plain meaning," which refers to the ordinary and customary meaning given to the terms by those of ordinary skill in the art. The ordinary and customary meaning of the term "automatic" is "*acting or operating in a manner essentially independent of external influence or control*" (see the amendment of 16 October 2009 which includes an attachment with the definition of "automatic").

When read in context of the claims, the meaning of the terminology "automatically grouping" which is performed by a "mobile station" or its "processor" means that **the claimed automatic grouping actions ("reading," "storing," and "repeating") are performed by the mobile station or processor in a manner independent of the user of the mobile station.** Put another way, it means that these actions are performed without user or manual intervention. This interpretation is consistent with the "automatic grouping" operation described in the specification. See e.g. FIG. 5 and page 20 at lines 13-16 of the application.

It is important to note that there is no dispute between the Applicant and the Examiner regarding the interpretation of the claimed "automatically grouping" as described. Rather, in the rejection of claims, the Examiner alleges that the Jin reference teaches or suggests these claimed limitations.

Essentially, the Examiner equates the manual process of Jin, where the user manually enters or selects data via the screen (see FIG. 2, paragraph 30, FIGs. 4a-4f, and paragraphs 40-44 of Jin), with the automatic grouping of user-specific information items as claimed and described. In particular, **the Examiner clearly appreciates that in Jin the user must regularly press the "next" button or "enter" on the mobile terminal for the manual entry of data (see the Office Action of 29 April 2010, on page 3 at lines 14-19, on page 3 at line 22 to page 4 at line 1, on page 4 at lines 7-8,**

and on page 4 at lines 12-17). As apparent, as Jin's process is performed in a manner that is dependent on the user of the mobile station for manual entry/selection of data; however, this is not that which is claimed and is in fact just the opposite.

As clearly apparent, Jin fails to teach or suggest any "automatic" grouping of user-specific information items in a user information file as claimed. Note further that the Examiner has failed to provide any reason whatsoever why it would have been obvious to one ordinarily skilled in the art under 35 U.S.C. § 103(a) to have modified the process of Jin to the claimed technique.

As the Examiner has committed clear error by failing to demonstrate each and every limitation in the prior art, the Applicant respectfully requests the panel to instruct the withdraw of the rejections and allowance of the application.

2. The Examiner Commits Clear Error In Failing To Support The Assertion That The Limitations Of Claim 1 Fail To Comply With The Written Description Requirement.

In the Office Action, the Examiner rejects claims 1-7, 9-22 and 32-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In these rejections, the Examiner makes reference only to claim 1. The Examiner states merely that ***"added limitation to claim 1 was not described in the specification."*** See the Office Action of 29 April 2010 on page 6 at lines 1-2.

The Examiner is clearly wrong, and commits clear error with respect to this assertion. For one, the Examiner refers only to claim 1 and fails to articulate rejection of any of the other claims. Secondly, the Examiner's remarks are sparse and he fails to describe with any level of specificity which particular limitations are not supported in the description.

The Applicant respectfully submits that all claim limitations added to claim 1 are clearly supported by the description as follows:

maintaining storage of a first file for a first application of the mobile station, the first file including a first user-specific information item which is utilized for identifying or contacting the user in the first application; [see e.g. page 20 at lines 13-16: "Advantageously, various user-specific information items that are associated with various files or applications and independently stored and maintained as separate items in the mobile station are automatically combined..."; see also e.g. FIG. 4 which shows files/applications 404, 406, 408, and 410 stored in the mobile station, where the files/applications include the user-specific items, and the description on page 16 at lines 9-32 to page 7 at lines 1-5; see also e.g. page 1 at lines 18-23: "[v]arious user-specific information items associated with these applications (a user name, a telephone number, an e-mail address, etc.) are independently stored and maintained as separate items in the mobile station. Since these items are independently stored and maintained, it is often difficult for the end user or subscriber of the mobile station to personally manage or communicate this information as a whole."]

maintaining storage of a second file for a second application of the mobile station, the second file including a second user-specific information item which is utilized for identifying or contacting the user in the second application; [same as above]

Based on the above, the Applicant respectfully requests the panel of Examiners to consider the present Request with respect to the clear errors made by the Examiner, and take appropriate action based on the same. Thank you.

Respectfully submitted,

/John J. Oskorep/

JOHN J. OSKOREP

Reg. No. 41,234

Date: 21 June 2010

JOHN J. OSKOREP, ESQ. LLC
ONE MAGNIFICENT MILE CENTER
980 N. MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 USA
Telephone: (312) 222-1860 Fax: (312) 475-1850